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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,031	01/12/2001	Keith Yeats	AC02758US	2192

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,031

Applicant(s)

YEATS ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1 to 8, 11 and 12 are objected to because of the following informalities:
In the $\text{Si}(\text{OR}_3)_3$ group, an oxygen atom should be attached to the left hand side of the Si atom. See the group on page 3 of the specification. Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 to 6, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Akiyama et al.

Akiyama et al. teach silicone containing aqueous coating compositions which are prepared by the polymerization of unsaturated monomers in the presence of an alkoxy-siloxane. See Example 1 and particularly note Example 3 in which a glycidyl methacrylate is polymerized with methyl methacrylate and butyl methacrylate. Ethyl Silicate 40 in this reaction mixture meets the polysiloxane having the formula required by the instant claims, and since the monomers are polymerized in the presence of the silicate, this also meets the reactive diluent limitation. Example 3 initially prepares a partial condensate. This meets the claimed composition since it contains a polysiloxane and an acrylic polymer obtained by polymerizing in the presence of a reactive diluent. On the other hand the coating composition of Akiyama et al. can be prepared without this partial condensate by simply polymerizing the unsaturated compounds in the presence of the polysiloxane. See for instance lines 52 to 62 of column 5.

As can be seen on column 13, the coating composition is applied to a substrate and cured at ambient temperature. In this manner, the instant claims are met by the prior art.

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The Examiner has attached column 13 of 5,593,732 to the 6,329,461 patent to support the Examiner's position that Ethyl Silicate 40 meets the claimed polysiloxane. In addition, column 11 of 6,476,160 is attached, showing the polysiloxane used in Example 7 of Akiyama et al., which also meets the claimed polysiloxane limitations.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al.

While Akiyama et al. do not show a composition meeting these amounts, column 9 teaches various amounts of each component that embrace that claimed. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In view of this, adjusting the amount of each component such that it falls within the broadly claimed ranges would appear to have been well within the skill of the ordinary artisan.

6. The Examiner acknowledges applicants' Declaration under 37 CFR 1.132, but the results therein are not persuasive in view of the newly discovered reference which anticipates polymerization in the presence of a reactive diluent.


7. The remaining references are cited as being of general interest. Tsubuko et al. teach polymerization in the presence of a non-reactive silicone diluent. Takami teaches polymerizable coatings having epoxy compounds and a reactive silicone. Yamauchi et al. show silicone modified acrylate polymer emulsions but fail to specifically show a composition as claimed. Nakai et al. teach the benefits of polymerizing vinyl monomers in the presence of an alkoxysiloxane polymer.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
April 2, 2003